R E M A R K S

A. INTRODUCTION

Prior to entry of this Amendment:

- Claims 1-23 were pending in the present application
- Claims 1-23 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 2-5, 7, 8, 12-21, and 24-53 will be pending
- Claim 2-5, 7, 8, 12-15, and 17-20 will be amended. Claims 2-5, 7, and 8 are now independent and are amended solely in order to incorporate all of the limitations of the base Claim 1—no change has been made to their scope. All of Claims 12-15 and 17-19 have been amended in order to depend from now independent Claim 8. Claim 20 has been amended such that the rank of the second gaming session is based on a rate of play of the second gaming session.
- Claims 24-53 will be added
- Claims 1, 6, 9-11, 22, and 23 will be cancelled without prejudice. Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more continuing applications.
- Claims 2-5, 7, 8, 30-32, 52, and 53 will be the only independent claims

B. DOUBLE PATENTING REJECTION

Claims 1-5 stand rejected on the ground of nonstatutory double patenting over specified claims of U.S. Patent No. 6319122.

We do not agree with this rejection.

Claim 1 has been cancelled without prejudice by this Amendment. Applicants believe that the subject matter of Claim 1 is patentable and intend to pursue that subject matter in at least one continuing application. Each of rejected Claims 2-5 has been amended solely in order to make it an independent claim—the scope of Claims 2-5 has not been altered by this Amendment.

With respect to Claims 2-5, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set

forth in Graham v .John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1). When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

The Examiner's finding of "common subject matter" alone cannot support the determination of double patenting. All of the specified issued claims require that the set of gaming sessions be "subsequent" and "initiated after the initiation of the gaming session of the player." None of Claims 2-5 requires such limitations. Further, each of Claims 2-5 recites specific features that were not addressed by the Examiner, and each requires that each at least one other gaming session has a respective rank that is not higher than the rank of the first gaming session. The issued claims do not expressly require such a feature. Although the pending and issued claims may overlap in scope with respect to some types of embodiments, no claims are identical in scope, and any differences must be identified and addressed by the Examiner in accordance with a proper obviousness analysis. Absolutely no motivation to modify or combine teachings is provided for the double patenting rejections. Lacking a motivation to modify the scope of the issued claims, there is no prima facie case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

We respectfully request reconsideration of the obviousness double patenting rejection of Claims 2-5.

C. SECTION 112 REJECTION—INDEFINITENESS

Claim 16 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner asserts: "There is improper antecedent basis for the phrase 'in which applying comprises….'". [Office Action, page 3]. We respectfully traverse the indefiniteness rejection.

The noted phrase had antecedent basis in Claim 1, which recites: *applying the at least one bonus to the first gaming session*. Claim 16 depends from Claim 15, which depended from Claim 1. . [Claim 15 now depends directly from Claim 8, which has been amended to incorporate all of the limitations of Claim 1. The amendment of Claims 8 and 15 has nothing to do with the Examiner's indefiniteness rejection of Claim 16.]. Accordingly, the scope of the subject matter of Claim 16, which describes one embodiment of *applying*, was and is reasonably clear. We respectfully request withdrawal of the indefiniteness rejection of Claim 16.

D. SECTION 103 REJECTIONS

Claims 1-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. Patent No. 6165071). We respectfully traverse the Examiner's Section 103(a) rejection.

Although we do not agree with the Examiner's rejection, Claims 1, 6, 9-11, 22, and 23 have been cancelled without prejudice.

1. Independent claim 2

The scope of Claim 2 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

determining a number of prior gaming sessions that are not concluded; and

determining the rank of the first gaming session based on the number.

The cited portion of Weiss has nothing to do with determining a rank of a gaming session based on how many prior gaming sessions that are not concluded. We respectfully request withdrawal of the Section 103 rejection of Claim 2.

2. Independent claim 3

The scope of Claim 3 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

determining a number of subsequent gaming sessions that are not concluded; and

determining the rank of the first gaming session based on the number.

The cited portion of Weiss has nothing to do with determining a rank of a gaming session based on how many subsequent gaming sessions that are not concluded. We respectfully request withdrawal of the Section 103 rejection of Claim 3.

3. Independent claim 4

The scope of Claim 4 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

determining a start time of the first gaming session; and

determining the rank of the first gaming session based on the start time.

The cited portion of Weiss has nothing to do with determining a rank of a gaming session based on its start time. We respectfully request withdrawal of the Section 103 rejection of Claim 4.

4. Independent claim 5

The scope of Claim 5 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

determining a duration of the first gaming session; and

determining the rank of the first gaming session based on the duration.

The cited portion of Weiss has nothing to do with a duration of a gaming session or determining a rank of a gaming session based on its duration. We respectfully request withdrawal of the Section 103 rejection of Claim 5.

5. Independent claim 7

The scope of Claim 7 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

providing an offer to assign the rank to the first gaming session in exchange for an amount of funds.

The cited portion of Weiss has nothing to do with an offer to assign a rank or providing such an offer, or in which determining a rank would comprise providing such an offer. We respectfully request withdrawal of the Section 103 rejection of Claim 7.

6. Claims 8 and 12-21

The scope of Claim 8 has not changed by this Amendment. Weiss does not teach or suggest:

in which determining the rank of the first gaming session comprises:

determining a rate of play of the first gaming session; and

determining the rank of the first gaming session based on the rate of play.

The cited portion of Weiss has nothing to do with determining a rate of play or in which determining a rank would comprise determining a rank based on a rate of play. All of Claims 12-21 now depend directly or indirectly from Claim 8. We respectfully request withdrawal of the Section 103 rejection of Claims 8 and 12-21.

In addition, new Claims 24-29 all depend from Claim 8. Also, new Claim 30 provides for a computer readable medium configured for providing the method of Claim 8, and apparatus Claim 31 incorporates that computer readable medium. We respectfully submit that new Claims 24-31 are allowable for at least the reasons stated above with respect to Claim 8.

E. NEW CLAIMS 32-53

New independent Claims 32, 52, and 53 all provide for:

determining a rank of the first gaming session based on at least one of the following:

a measure of wagering in the first gaming session,

a number of prior gaming sessions of at least one other player, and

a number of subsequent gaming sessions of at least one other player;

Weiss does not teach or suggest determining a rank of a gaming session based on any one or any combination of the above types of information. Specifically, Weiss does not suggest determining a rank of a gaming session based on a measure of wagering (e.g., an amount wagered, a rate of play, a number of handle pulls) or based in particular on how many prior and / or subsequent gaming sessions of other players there are.

Accordingly, we submit that new Claims 32-53 contain allowable subject matter.

F. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a one-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

Charge:	$120.00
Deposit Account:	50-0271
Order No.:	01-040

Please charge any appropriate fees set forth in §§ 1.16 – 1.18 for this paper and for any accompanying papers to Deposit Account 50-0271. Please credit any overpayment to the same account.

G. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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